

REMARKS

This application was originally filed on 31 December 2001 with twenty three claims, one of which was written in independent form. No claims have been allowed.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,335,224 to Peterson *et al.* ("Peterson"). The applicant respectfully disagrees.

"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35 U.S.C. § 102 that, "a person shall be entitled to a patent unless," concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see Graham and Adams." *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). "As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103'." *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

"The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it." *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

The applicant respectfully submits the Examiner has failed to meet the burden of proof required to establish a *prima facie* case of anticipation. Section 2131 of the Manual of Patent Examiner's Procedure provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987). . . . 'The identical invention must be shown in as complete detail as contained in the . . . claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The elements must be arranged as in the claim under review *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Claim 1 recites, "overcoating said micromechanical structures with a protective layer" and "overcoating said protective layer with a brittle layer." The Examiner cites column 8, lines 65-67 as teaching the overcoating of a protective layer with a brittle layer. Column 8, lines 60-67 of Peterson states, "Alternatively, protective coating 14 could be patterned in a manner to exclude coating 14 from the wafer saw streets (e.g. lines where the saw cuts along), prior to saw cutting. This would be desirable to avoid contaminating the dicing saw with unwanted debris (e.g. organic debris) generated by cutting of coating 14. Exclusion of coating 14 from the wafer saw streets can be accomplished by masking during deposition of the coating."

This passage simply cannot support the Examiner's claim that Peterson anticipates the limitations recited by Claim 1. The Examiner's rejection is unsupported by the prior art, fails to establish a *prima facie* case of anticipation, and therefore should be withdrawn.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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